



3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2020-0042]

Proposed Continuing Legal Education Guidelines

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Request for comments.

SUMMARY: This request for comments seeks public input on proposed guidelines regarding continuing legal education (CLE). Pursuant to the final rule published on August 3, 2020, registered patent practitioners and individuals granted limited recognition to practice before the United States Patent and Trademark Office (USPTO or Office) in patent matters will be required to biennially submit a mandatory registration statement beginning on March 1, 2022. On the registration statement, practitioners may state whether they have completed 6 credits of CLE within the previous 24 months. The USPTO has prepared proposed CLE guidelines, attached to this request for comments as Appendix 1, which advise practitioners and providers as to the proposed types of CLE courses and activities that will qualify for USPTO CLE credit. In this request for comments, the Office seeks input on the proposed guidelines.

DATES: Comment Deadline Date: Written comments must be received on or before

[INSERT DATE 90 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: Written comments should be sent by email addressed to

CLEguidelines@uspto.gov. Comments may also be submitted by postal mail addressed

to Mail Stop OED, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of William Covey, Director for the Office of Enrollment and Discipline, CLE Guidelines Request for Comments 2020.

Although comments may be submitted by postal mail, the Office prefers to receive comments by email to more easily share all comments with the public. The Office prefers the comments to be submitted in plain text but also accepts comments submitted in portable document format or DOC format. Comments not submitted by email should be submitted on paper in a format that facilitates convenient digital scanning into portable document format.

The comments will be available for public inspection at the Office of Enrollment and Discipline (OED), located in Madison West, Eighth Floor, 600 Dulany Street, Alexandria, VA 22314. Comments will also be available for viewing via the Office's website (www.uspto.gov). Because comments will be made available for public inspection, information that the submitter does not desire to be made public, such as address or phone number, should not be included.

FOR FURTHER INFORMATION CONTACT: William Covey, OED Director, by telephone at 571-272-4097.

SUPPLEMENTARY INFORMATION:

Summary

In this request for comments, the Office seeks feedback and information regarding the proposed CLE guidelines attached as Appendix 1. The goal of the proposed guidelines is to clarify for registered practitioners and those granted limited recognition pursuant to 37 CFR 11.9(b) what types of CLE classes or activities will qualify for USPTO CLE credit. The guidelines also seek to establish a procedure for approving CLE courses that would qualify for USPTO CLE credit. Finally, the guidelines seek to establish the type of recognition practitioners will receive if they certify on their registration statements that they have completed 6 credits of CLE in the preceding 24 months.

Background

As set forth in the final rule, published on August 3, 2020 (85 FR 46932) beginning on March 1, 2022, active patent practitioners will be required to submit a biennial electronic registration statement. 37 CFR 11.11(a)(2). On the registration statement, practitioners may also certify that they have completed 6 credits of CLE within the preceding 24 months, with 5 of the credits in patent law and practice and 1 of the credits in ethics. 37 CFR 11.11(a)(3).

The Office recognizes that patent practitioners and CLE providers may seek more specific guidance as to how the USPTO will implement the CLE provisions. In order to assist patent practitioners and CLE providers in determining what courses or activities enable a practitioner to make the CLE certification, the USPTO has prepared the attached proposed CLE guidelines. The proposed guidelines also address the form of recognition

practitioners will receive when they make the CLE certification on their biennial registration statement.

Request for Public Comments

The Office seeks written public comments on the proposed CLE guidelines attached as Appendix 1 to this request.

The Office welcomes any comments from the public on the topics covered in this notice.

The Office also poses specific questions below and invites public feedback on those questions.

Topic 1: Subject Matter of Courses Qualified for USPTO Patent CLE Credit

The proposed CLE guidelines provide that a practitioner may obtain USPTO patent CLE credit for a course that pertains to any topic listed in 37 CFR 11.5(b)(1), which defines practice in patent matters before the USPTO. Applicable topics include, but are not limited to: preparation and prosecution of patent applications, determining and rendering opinions on patentability, and drafting documents to be presented in any patent-related proceeding before the USPTO, including proceedings before the Patent Trial and Appeal Board (PTAB). Accepted topics also include litigation that pertains to any of the topics listed in 37 CFR 11.5(b)(1).

As noted in the final rule, the purpose of the CLE certification and recognition is to incentivize practitioners to engage in CLE relevant to their practice before the Office. As explained in the NPRM, “Ideally, when practitioners are well-trained and well-educated in patent law and practice, higher quality applications are filed, prosecution is more efficient, and patent grants become stronger, more reliable, and more predictable.” 84 FR at 37415. Accordingly, the proposed CLE guidelines provide that patent CLE credit may

only be obtained for courses that pertain directly to practice in patent matters before the USPTO.

The USPTO invites comment on the parameters to be used to determine what subject matters beyond those listed in 37 CFR 11.5(b)(1) would qualify for patent CLE credit, if any.

Topic 2: Other Activities That May Qualify for USPTO CLE Credit

The final rule states that patent practitioners may obtain up to two of the five credits in patent law and practice by participating in the USPTO Patent Pro Bono Program. *See* 37 CFR 11.11(a)(3)(ii). The final rule further provides that patent practitioners will earn one hour of USPTO patent CLE credit for every three hours of pro bono service. 37 CFR 11.8(a)(3)(ii).

The proposed CLE guidelines set forth certain other activities that may qualify for USPTO CLE credit, including service in a law school clinic participating in the USPTO Law School Clinic Certification Program. The proposed guidelines also limit the number of credit hours that a practitioner may claim related to such activities.

The USPTO invites comments on whether a practitioner may earn income and CLE credits simultaneously (for example, if a practitioner is paid for a speaking engagement on a CLE-eligible topic).

Topic 3: Providers of USPTO Patent CLE

The proposed CLE guidelines set forth eligible subject matter for USPTO patent CLE credit (that is, CLE courses provided by the USPTO) and explain that any course approved by a state bar for ethics credit may also be used for USPTO ethics CLE credit. However, the guidelines do not currently set forth a procedure by which providers may

apply to the USPTO for approval of CLE courses for USPTO credit in patent law and practice and/or ethics.

The proposed CLE guidelines could provide a procedure for approval of courses by non-USPTO providers (that is, CLE courses offered by providers other than the USPTO). The USPTO invites comments regarding the merits of implementing such a procedure or suggestions concerning the specific method by which the USPTO could review and approve such courses.

Topic 4: Form of Recognition for Practitioners Who Certify Completion of CLE

The final rule provides that the OED Director may publish whether each registered practitioner or person granted limited recognition under 37 CFR 11.9 has certified that he or she has completed the 6 USPTO CLE credits in the past 24 months. 37 CFR 11.11(a)(1). The proposed CLE guidelines provide that such recognition will take the form of a statement on the practitioner's individual profile on the online practitioner database. The USPTO invites comments on what manner the recognition should take.

Questions Regarding the Proposed CLE Guidelines

As noted above, the Office welcomes any comments from the public on any portion of the proposed CLE guidelines. The Office is particularly interested in the public's input on the following questions:

1. What course topics should qualify for USPTO patent CLE credit?
2. What parameters should be used to determine what subject matters beyond those listed in 37 CFR 11.5(b)(1) would qualify for patent CLE credit, if any?

3. What activities should qualify for USPTO CLE credit, either in patent law and practice or ethics?
4. Should organizations or providers outside the USPTO be authorized to deliver USPTO CLE courses? If so, how should such courses be approved?
5. In what manner should the USPTO recognize practitioners who make the CLE certification on their mandatory registration statement?
6. Are there any other issues or concerns that the USPTO should consider regarding the CLE guidelines? If so, what are they and how and why would they apply?

Dated: October 2, 2020.

Andrei Iancu,

Under Secretary of Commerce for Intellectual Property and

Director of the United States Patent and Trademark Office.

Appendix 1

USPTO Proposed Continuing Legal Education Guidelines

The following USPTO CLE guidelines are intended to advise practitioners as to what types of courses or activities qualify for USPTO patent and ethics credit, how to calculate CLE credit for a given course or activity, and how providers may obtain approval of a CLE course for USPTO patent or ethics credit.

If practitioners have further questions regarding CLE that are not addressed in this document, they are encouraged to contact the OED at 571-272-4097 or oed@uspto.gov.

I. Voluntary CLE Certification

A. Certification for Active Registered Patent Practitioners and Persons Granted Limited Recognition Pursuant to 37 CFR § 11.9

37 CFR 11.11(a)(2) provides that registered patent practitioners and persons granted limited recognition pursuant to 37 CFR 11.9(b) are required to biennially file a mandatory registration statement. On the statement, practitioners will state whether they have voluntarily completed 6 CLE credits within the 24 months preceding the filing of the registration statement (the reporting period). *See also* 37 CFR 11.11(a)(3)(i). Five of the six credits must be in patent law and practice, and one credit must be in ethics. 37 CFR 11.11(a)(3)(ii).

Persons who certify that they have completed six CLE credits as described above will be recognized in the USPTO's online practitioner database. Such recognition will consist of a notation on the practitioner's individual profile, which states, "This practitioner has

certified completion of six credits of continuing legal education within the previous 24 months.”

No practitioner or person granted limited recognition pursuant to 37 CFR 11.9(b) is required by the USPTO or the OED to complete CLE credits. The OED notes that this recognition does not constitute endorsement of any particular practitioner or CLE.

B. Certification for Persons Newly Registered or Granted Limited Recognition

At the time an individual is newly registered to practice in patent matters before the USPTO or granted limited recognition pursuant to 37 CFR 11.9(b), he or she will submit a registration statement. In order to complete the registration statement, the practitioner shall state whether he or she has completed six credits of CLE within the applicable reporting period, consisting of five credits in patent law and practice and one credit in ethics.

Thereafter, the practitioner or individual granted limited recognition will be required to timely file biennial registration statements, which will include a voluntary CLE certification.

C. Calculation of CLE Credit Hours

Practitioners may earn 1 credit hour of CLE for every 50 minutes of instruction time or other accredited activity. Practitioners may not earn CLE credit in increments of less than 0.5 credit hours. Credit hours may be calculated based on the following examples:

0-24 minutes of instruction time or accredited activity = 0 CLE credit hours

25-49 minutes of instruction time or accredited activity = 0.5 CLE credit hours

50-74 minutes of instruction time or accredited activity = 1.0 CLE credit hours

75-99 minutes of instruction time or accredited activity = 1.5 CLE credit hours

100-124 minutes of instruction time or accredited activity = 2.0 CLE credit hours

125-149 minutes of instruction time or accredited activity = 2.5 CLE credit hours

150-174 minutes of instruction time or accredited activity = 3.0 CLE credit hours

Practitioners may not earn partial credit for attendance at a portion of a course or CLE session. Credit may only be earned by attending an entire CLE course or session.

D. Carry-Over of CLE Credits

Practitioners who earn more than six CLE credit hours in a reporting period are permitted to carry over up to three CLE credit hours from that reporting period to the next reporting period, up to two of which may be in patent law and practice and up to one of which may be in ethics.

II. Activities for Which USPTO CLE Credit May Be Earned

A. Attendance at CLE Courses Completed During a Reporting Period

Practitioners may earn CLE credit by attending a CLE course in either (1) patent law and practice or (2) ethics.

Practitioners may not earn CLE credit for repeating a course or program with identical content, in any format, even if the course or program is repeated in a different biennial registration period. Practitioners may earn CLE credit for completing an updated version of a course or program the practitioner previously completed.

1. CLE Courses in Patent Law and Practice

Practitioners may earn patent CLE credit by attending a CLE course on the topic of patent law and practice.

In general, courses designated for USPTO patent CLE credit will pertain to any of the topics listed in 37 CFR 11.5(b)(1), which defines practice in patent matters before the USPTO. Applicable topics include, but are not limited to:

- Preparation and prosecution of patent applications;
- Consulting with or giving advice to a client who is contemplating filing a patent application or other document with the Office, including considering the advisability of relying on alternative forms of protection that may be available;
- Drafting a specification of claims of a patent application;
- Drafting an amendment or response to an Office communication;
- Determining and rendering opinions on patentability;
- Drafting documents to be presented in any patent-related proceeding before the USPTO, including proceedings before the PTAB;
- Drafting an assignment of rights in an issued patent, patent application, or in contemplation of the filing of a patent application; and
- Litigation that pertains to the topics listed in 37 CFR 11.5(b)(1).

The USPTO offers numerous opportunities to earn patent CLE credit at no cost. USPTO CLE courses are listed on the USPTO website, which contains a schedule of upcoming courses and links to USPTO CLE courses that are available on demand.

2. CLE Courses in Ethics

Practitioners may obtain USPTO ethics CLE credit by attending a CLE course that is offered by the USPTO for ethics CLE credit. Practitioners may also obtain USPTO ethics CLE credit by attending a CLE course that has been approved by any state bar for ethics

credit. In general, courses accepted for USPTO ethics CLE credit will pertain to a practitioner's obligations under the USPTO Rules of Professional Conduct, including a practitioner's obligations under such rules to clients; prospective clients; and/or the USPTO, courts, and other legal institutions.

B. Other Activities for Earning Credit During a Reporting Period

1. Participation in the USPTO Patent Pro Bono Program

Practitioners may earn up to two CLE credits in patent law and practice by participating in the USPTO Patent Pro Bono Program. Practitioners may earn one credit hour of CLE in patent law and practice for every three hours of service provided to a client through the USPTO Patent Pro Bono Program.

2. Participation in the USPTO Law School Clinic

Practitioners may earn up to two CLE credits in patent law and practice by taking part in a law school clinic that participates in the USPTO Law School Clinic Certification Program. Practitioners may earn one credit hour of CLE for every three hours of service in such a clinic.

3. Presenting or Preparing for a Course Approved for USPTO CLE Credit

Practitioners may earn up to two CLE credits in patent law and practice or up to one credit in ethics for either speaking at a USPTO-accredited CLE course or preparing written materials for such a CLE course (but not both). Credit for preparation will be awarded on the basis of time spent by a practitioner either (1) preparing written materials for use in the presentation of the course; or (2) preparing a presentation as an instructor or

presenter for the course. The number of preparation minutes shall not exceed four times the number of instructional minutes in the presentation being prepared.

4. Writing

Practitioners may earn up to two CLE credits in patent law and practice or up to one credit in ethics for writing, as an author or co-author, materials published in the form of an article, chapter, or book that contributed substantially to the continuing legal education of the author or co-author and other practitioners, and that was not done as part of the practitioner's regular employment, as a service to the practitioner's clients, or as a marketing device for the practitioner or the practitioner's employer.

5. Teaching at an Accredited Law School

Practitioners may earn up to two CLE credits in patent law and practice or up to one credit in ethics for teaching, lecturing, or speaking on (1) legal ethics, or (2) patent law and practice, as defined in part VI(B) of these guidelines, in the position of a part-time faculty member in any law school accredited by the American Bar Association.

C. Non-qualifying Activities

No CLE credit can be claimed for the following activities:

- Activity done in the ordinary course of practicing in patent matters before the USPTO, the performance of regular employment, or as volunteer service to clients, bar organizations, or the general public (except as noted above)
- Activity associated with membership in an organization, including committee meetings, business meetings, or work sessions
- Legislative activities and/or lobbying

- Reading or reviewing written materials outside the context of preparing to present a CLE program approved by the USPTO for CLE credit (or a course for which such approval has been sought)
- Solicitation of clients or other marketing or promotional activities

III. Recordkeeping

It is recommended that practitioners who certify completion of CLE keep records that substantiate such completion for three previous reporting periods (i.e., six years).

Although there is no specific recordkeeping requirement, practitioners should be aware that the USPTO's OED may request that a practitioner supply documentation that substantiates his or her completion of CLE or "other activities." Practitioners are reminded that they have ethical obligations to be complete, accurate, and truthful in all of their representations to the USPTO. Consequently, practitioners may be subject to discipline under the USPTO Rules of Professional Conduct if their CLE certifications are false or misleading.